

The opinion in support of the decision being entered today was *not* written for publication in and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOROTHEA R. SMITH

Appeal No. 2006-2488
Application No. 10/700,425
Technology Center 3700

Decided: March 22, 2007

Before TERRY J. OWENS, JENNIFER D. BAHR, LINDA E. HORNER,
Administrative Patent Judges.

OWENS, *Administrative Patent Judge.*

DECISION ON APPEAL

The Appellant appeals from a rejection of claims 1-4, 6-8 and 11-13, which are all of the pending claims.

THE INVENTION

The Appellant claims a method of using a jigsaw puzzle to create a graphical depiction of a person's life. Claim 1 is illustrative:

1. A method of creating a graphical depiction of a person's life, comprising the steps of:

providing a first plurality of puzzle pieces that represent different major life events, including birthday, graduation day and wedding day that may, or may not, occur in a person's life; and

joining puzzle pieces together that correspond to events that have actually occurred in a person's life to create a puzzle assembly that is a graphical depiction of life events of that person.

THE REFERENCES

Thompson	US 723,425	Mar. 24, 1903
Guill	US 4,417,732	Nov. 29, 1983
Collins	US 6,619,661 B1	Sep. 16, 2003
Hall	US 6,708,973 B1	Mar. 23, 2004

(filed Feb. 20, 2003)

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1-4 and 6-8 over Thompson; claims 11-13 over Collins; claims 11 and 12 over Guill; and claim 13 over Guill in view of Hall.

OPINION

We affirm the aforementioned rejections.

Rejection over Thompson

Thompson discloses a puzzle comprising 1) one or more pieces having a picture thereon, and pieces that are adjacent to those pieces and identify the adjacent picture, and 2) pieces having thereon the result of a mathematical computation, and pieces that are adjacent to those pieces and show one or more mathematical computations that produce the adjacent result (p. 1, ll. 49-63; p. 1, l. 93 – p. 2, l. 26).

The Appellant argues that “[t]he Thompson patent does not disclose puzzle pieces that correspond to different commonly occurring life events, including

birthday, graduation day and wedding day, that may or may not occur in a person's life" (Br. 7). That argument is not persuasive because the indicia on the Appellant's puzzle pieces is nonfunctional descriptive material, i.e., it has no new and unobvious functional relationship with the substrate. *See In re Gulack*, 703 F.2d 1381, 1386, 217 USPQ 401, 404 (Fed. Cir. 1983). Without the indicia, the pieces still function as puzzle pieces, and without the puzzle pieces the indicia can be put on any other substrate. Regardless, Thompson's pictures correspond to commonly occurring or major life events that may or may not occur in a person's life such as doing or watching a handstand, wearing a hat for a special occasion, doing something special with a man, girl or dog, or learning new mathematical computations. During patent prosecution, claims are to be given their broadest reasonable interpretation consistent with the specification, as the claim language would have been read by one of ordinary skill in the art in view of the specification. *See In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). The Appellant's Specification indicates that the claim terms "major life events" and "commonly occurring life events" include a first kiss and applying to a medical school (p. 10, l. 6; p. 11, l. 12). Thus, the Specification indicates that the claim terms "major life events" and "commonly occurring life events" are broad enough to encompass the events pointed out above that correspond to Thompson's puzzle pictures.

The Appellant argues that "[t]he Thompson patent also does not disclose the methodology of adding such puzzle pieces to a puzzle after such a major life event has occurred" (Br. 7). The Appellant's claims do not require adding each puzzle piece after the corresponding event but before the next event. The claims are broad enough to encompass assembling the entire puzzle after all of the events have

occurred. Thompson's disclosure that the pictures are of familiar objects and ordinary Arabic numerals (p. 1, ll. 48-49 and 90-91) at least would have fairly suggested, to one of ordinary skill in the art, making the puzzle for people who have had commonly occurring life experiences that have given them familiarity with the objects and exposure to ordinary Arabic numerals.

For the above reasons we are not convinced of reversible error in the rejection over Thompson.

Rejection over Collins

Collins discloses a circular jigsaw puzzle comprising 1) a center ring of pieces having thereon numerical operands, 2) a middle ring of pieces having thereon the same mathematical operator and, outside the mathematical operator, a numeral and an equal sign, and 3) an outer ring of identically-shaped pieces having numbers thereon which, when the puzzle is correctly assembled, are the result of the operation of the mathematical operator on the numbers on the center and middle rings (col. 2, l. 36 – col. 3, l. 17; figs. 2-4). The puzzle is in a container comprising a transparent tray and a transparent cover (col. 2, ll. 26-27). The puzzle pieces have indicia on their undersides which, when the puzzle is correctly assembled and the transparent tray is covered and inverted, appear as a picture (col. 2, ll. 26-35; fig. 6).

The Appellant argues that the Examiner's "argument that math equations qualify as life events is an argument that is stretched beyond the bounds of reason" (Br. 5). The Appellant's claim 11 requires puzzle pieces that correspond to different commonly occurring life events, and learning the solution to each type of mathematical equation, first with small numbers and then with larger numbers, is a different life event and is commonly occurring.

We therefore are not convinced of reversible error in the rejection over Collins. Moreover, as discussed above regarding the rejection over Thompson, the Appellant's claimed invention is anticipated by Collins because the indicia on the Appellant's puzzle pieces is nonfunctional descriptive material. Anticipation is the epitome of obviousness. *See In re Skoner*, 517 F.2d 947, 950, 186 USPQ 80, 83 (CCPA 1975); *In re Pearson*, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

Rejections over Guill and over Guill in view of Hall

Guill discloses a jigsaw puzzle for use by adults (col. 1, ll. 7-9). The puzzle has 11 playing pieces numbered 2 to 12 corresponding to the numbers obtained from a roll of a pair of dice (col. 2, ll. 17-24). Each puzzle piece preferably shows part of a scantily clad voluptuous woman (col. 2, ll. 31-33). The pieces are placed on the puzzle in numerical order based upon rolls of the dice (col. 2, ll. 24-27).

The Appellant argues that rolling dice is not a major life event (Br. 6). Claims 11-13 to which Guill is applied do not recite "major life events" but, rather, recite "commonly occurring life events". Rolling dice is a commonly occurring life event. Moreover, "life events", as that term is used by the Appellant, include a first kiss (Specification 10: 4-6). Accordingly, the voluptuous female body parts on Guill's puzzle pieces reasonably appear to correspond to different commonly occurring life events that may or may not occur. Furthermore, as discussed above with respect to the rejection over Thompson, the Appellant's claimed invention is anticipated by Guill because the indicia on the Appellant's puzzle pieces is nonfunctional descriptive material. Anticipation is the epitome of obviousness. *See Skoner*, 517 F.2d at 950, 186 USPQ at 83; *Pearson*, 494 F.2d at 1402, 181 USPQ at 644.

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The Appellant does not present a substantive argument as to the separate patentability of dependent claim 13 rejected over Guill in view of Hall (Br. 7).

For the above reasons we are not convinced of reversible error in the rejections over Guill and over Guill in view of Hall.

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DECISION

The rejections under 35 U.S.C. § 103 of claims 1-4 and 6-8 over Thompson, claims 11-13 over Collins, claims 11 and 12 over Guill, and claim 13 over Guill in view of Hall, are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

jrg

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